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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,125	06/20/2002	Laurent Pujol	024118-00042	3539

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EXAMINER

SMITH, TERRI L

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/069,125	PUJOL, LAURENT	
	Examiner	Art Unit	
	Terri L. Smith	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed March 1, 2002 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Form PTO-1449 was not submitted. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Drawings

2. The drawings are objected to because Figs. 3–43 are not in English. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the applicant will be notified and informed of any required corrective action in the next Office Action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: On page 4, is the ")" (right parenthesis) (last line) supposed to be there? If it is supposed to be there, where should the "(" (left parenthesis) go? If it does not belong there, it is suggested to delete it.

On page 13, should there be a word, a punctuation mark, or a symbol between the numbers "10 12" (line 10)? It is unclear what is being stated as it is currently written.

On page 14, it appears that the "/" (slash) after μA (line 18) should be a "." (period).

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 3 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

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invention. On page 8 of the disclosure, the sentence “In a preferred embodiment pulse trains or “bursts” of 5/5 to 10/10 or 15/15, preferably 10/10, are to be applied.” (lines 6–17) introduces the ratios 5/5, 10/10, and 15/15. However, the ratios are not defined. What do the ratios mean? What do they represent? Are they supposed to somehow correlate with the “bursts,” and if so, how?

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 1–11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989). In the present instance, claim 1 recites the broad recitation “the human or animal” (line 1), and the claim also recites “the horse in particular” (lines 1–2) which is the narrower statement of the range/limitation. Furthermore, “which are positioned” (line 3) is vague. It sounds as if there is a connection to the body. Apparatus claims cannot claim a connection to the body. It is suggested to use “adapted to be positioned” or “for positioning” language. In addition, “the subject” (line 3) lacks antecedent basis. Further, “to cause electric stimulation trains to pass ...” (line 4) is vague because it is unclear what is causing the electric stimulation trains. Additionally, the parenthetical phrase

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(line 5) is vague and it is unclear if this is part of the claim. Moreover, the limitation “square wave signals are not involved” (line 8) is vague. It is unclear with what aspect of the device they are not involved (e.g.; the whole system, the device, the pulses, etc.). In addition, “the excitation period” (lines 10 and 12) and “the rest or relaxation period” (lines 10 and 14) are inferentially included and vague. It cannot be determined if these elements are being positively recited or functionally recited. To positively claim the elements, it is suggested to first positively recite the elements. Otherwise functional language such as “for” or “adapted to be” should be used.

In claim 2 “the electric current applied” in line 1 lacks antecedent basis. There is insufficient antecedent basis for these limitations in the claim. Further, it is unclear what “the intensity” represents as it relates to the electric current. Also, the term “preferably” (lines 2–3) is vague and indefinite. It does not clearly define the range of amperes. Additionally, it is unclear what the parenthetical “one microampere” (line 3) is supposed to represent.

In claim 3, the term “preferably” (line 2) is vague and indefinite. It does not clearly define the trains of pulses or “bursts.”

In claim 5, “the frequency” (line 1) is vague. A pulse does not have a frequency, but a pulse train can have a frequency. Also, the term “preferably” (line 2) is vague and indefinite. It does not clearly define the frequency ranges.

In claim 6, it is unclear what “a working period” (line 2) is. Additionally, “preferably” (line 2) is vague and indefinite as it does not clearly define working period ranges.

In claim 7, “a rest period” (line 2) is vague. It is unclear what a rest period is. It is unclear if this is the same rest period used in claim 1 or two different periods. Additionally, in line 2, “a rest period ranging from 300 to 900 milliseconds” is indefinite. Also, a broad range or

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limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989). In the present instance, claim 7 recites the broad recitation “from 300 to 900 milliseconds” (line 2), and the claim also recites “from 400 to 850 milliseconds” (claim 1, line 14) which is the narrower statement of the range/limitation.

In claim 8, “is suitable for delivery” (lines 1–2) is vague since it is unclear if the Applicant is stating the device actually performs these functions or whether the device is capable of performing these functions. Further, the symbol “>>” (lines 8 and 17) are confusing. What do they mean? In addition, the quotation marks around stimulating (line 12) and turbo (line 12) are vague as it is unknown what effect they have on the terms. Also, the claim recites “the preceding one” in line 13. There is insufficient antecedent basis for this limitation in the claim. Additionally, “2 milliseconds of work” (line 8), “500 milliseconds of rest” (line 8), “6 milliseconds of work” (line 17), “650 milliseconds of rest” (line 17) are vague. It is unclear what the terms work and rest are referring to and if they are the same as excitation and rest in claim 1.

Claim 9 recites “the 10/10 type” in line 2. There is insufficient antecedent basis for this limitation in the claim. In addition, “preferably” (line 2) is vague and indefinite as it does not clearly define the pulse trains.

In claim 10, the quotation marks around contact (line 2) and alligator (line 7) are vague as it is unknown what effect they have on the terms. Additionally, “positioned on” (line 3) is vague. It sounds as if there is a connection to the epidermis. Apparatus claims cannot claim a

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connection to the epidermis. It is suggested to use “adapted to be positioned” or “for positioning” language. Further, “implanted” (line 9) is vague. It is suggested to use “adapted to be implanted” language.

In claim 11, “x couples” (line 2) and “(+)(-)” (line 2) are vague and indefinite. It is unclear what information is to be included in the limitation. Also, “etc. ...” (line 3) is vague as it is unknown what scope “etc.” has on the limitation. The phrase “such as” (line 3) renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1–11 are rejected under 35 U.S.C. 102(b) as being anticipated by Klotz, U.S.

Patent 5,725,563.

Klotz discloses a generator and at least two electrodes positioned on the epidermis (Figs. 1–2; column 5, lines 17–18); an excitation period is shorter than a rest or relaxation period; an excitation period ranges from 2 to 8 milliseconds and a rest or relaxation period ranges from 400 to 850 milliseconds (Fig. 3; column 6, lines 26–34); the intensity of an electric current applied is lower than or equal to 1 mA (one milliamperere), and is preferably of the order of 6 to

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300 μ A (one microampere), preferably 6 to 50 or 100 or 150 or more (column 6, line 17); each train of pulses exhibits reverse of polarity relative to the preceding train (column 6, lines 10–12); the frequency of each pulse ranges from 0.1 to 3 Hertz, and preferably ranges from 0.7 to 2.5 Hertz, preferably near 1.5 or 2 Hertz (column 6, lines 33–34); the pulses of electric current exhibit a working period ranging from 1 to 12, preferably 1 to 8, milliseconds, preferably 2 or 6 milliseconds (column 6, lines 28–30); the pulses of electric current exhibit a rest period ranging from 300 to 900 milliseconds, preferably 400 to 700 milliseconds, preferably 500 or 650 milliseconds (column 6, lines 33–34); a first type of current which is a “regulating or reeducating” current, centered on a setting of around 2 milliseconds of work, 500 milliseconds of rest, $>>1.99$ Hz (column 6, lines 29, 33, and line 49); at least two contact electrodes of the flat type, carbonated or non-carbonated, adhesive or non-adhesive, with or without hydrogel, positioned on or adhering to the epidermis (Fig. 1; column 5, lines 17–18); device comprises x couples of electrodes, such as two electrodes or four and electrodes covering two areas of treatment (Fig. 1; column 5, lines 30–35).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Terri L. Smith whose telephone number is 571-272-7146. The Examiner can normally be reached on Monday - Friday, between 7:30 a.m. - 4:00 p.m..

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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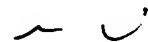
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TLS

May 12, 2005

12 May 2005



GEORGE R. EVANISKO
PRIMARY EXAMINER

5/12/5